

REMARKS

Claims 91-113 are pending and at issue in the application with claims 91 and 103 being independent claims. As a result, 2 independent claims remain in the application as previously paid for, and 23 total claims remain in the application as previously paid for. The applicant believes no fee is due. However, the commissioner is hereby authorized to charge any deficiency in the amount enclosed or any additional fees which may be required under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 13-2855. Reconsideration and withdrawal of the rejections in view of the remarks below is respectfully requested.

The applicant respectfully traverses the rejections of claims 91-96, 98-100, 103-108, 110 and 111 as unpatentable over Acres (U.S. Patent No. 6,254,483) in view of Burns et al. (U.S. Patent No. 6,254,483). The applicant further traverses the rejections of claims 101, 102, 112 and 133 as unpatentable over Acres in view of Burns et al. and further in view of Miura (U.S. Patent No. 6,354,943), and the rejections of claims 97 and 109 as unpatentable over Acres in view of Burns et al. and further in view of Weiss (U.S. Patent No. 5,611,730).

Independent claim 91 is directed to a gaming unit that includes (1) a time generator that generates a time signal indicative of a time of day, and (2) a controller programmed to change a **minimum bet to be inputted via the input device for the video gambling game in response to the time signal**.

Independent claim 103 is directed to a gaming unit that includes (1) a time generator that generates a time signal indicative of a time of day, and (2) a controller programmed to change a **denomination for the deposit of currency required to begin the video gambling game in response to the time signal**.

The applicant submits that claims 91 and 103 are not rendered obvious by Acres in view of Burns et al. The action does not establish a *prima facie* case of obviousness, because Acres and Burns et al. fail to disclose all of the limitations of claims 91-113.

As established in previous responses, the Acres patent generally discloses varying configuration parameters, such as game speed, payback percentage and accrual of wagers in a bonus pool, in response to monitored variables, such as time, level of player play or rate of overall play in order to influence the net cost to the player per unit time for playing casino games. (See, column 6, lines 13-62; column 9, lines 4-7). The effective wager per unit time

is a function of payback percentage and game speed. (See, column 2, lines 35-55). While Acres changes various parameters in response to time in order to influence the wager per unit time, those parameters do not include a minimum bet to be inputted via an input device or a denomination for the deposit of currency required to begin a game. In particular, Acres varies the game speed, payback percentage or accrual of wagers in response to time. The minimum bet or denomination remains the same regardless of the time of day, month, year, etc. The action acknowledges that Acres does not disclose a controller changing a minimum bet for a video gambling game in response to a time signal. (See action, page 4).

While the action cites Burns et al., Burns et al. does not disclose or suggest changing the minimum bet or the denomination in response to a time signal. Burns et al. discloses a coinless and paperless slot machine wherein a wager limit may be changed at any time. The portion of Burns et al. cited in the action states only that "it is possible to change the wager limits of any or all of the individual slot machines. Thus, the minimum wager of the slot machines can be changed at any time. It would also be possible to allow the player to select the wager limit." The cited portion does not specify how the wager limit is changed, merely that the wager limit is *capable* of being changed. However, the cited portion must be read in the context of the entire reference and not in a vacuum. (See MPEP 2141.02(VI) "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." (emphasis in original)). When reviewing the reference as a whole, Burns et al. discloses offering the player the choice of different minimum wagers. (See column 5, lines 16-31; Figs. 5a and 5b). In other words, Burns et al. allows the minimum wager of the slot machine to be changed at any time by providing a player with the opportunity to select the minimum wager. Burns et al. does not disclose changing a minimum bet to be inputted via an input device in response to a time signal as recited by claims 91-102 or changing a denomination for the deposit of currency required to begin a game in response to a time signal as recited by claims 103-113.

Indeed, the action does not actually point to any disclosure or suggestion in the prior art of changing either a minimum bet or a denomination in response to a time signal. Instead, the action cites Acres and Burns et al. as merely teaching that it is desirable to change the cost of a gaming machine during certain time periods to increase revenue and attract more players as motivation to combine Acres and Burns et al. (See action, page 5). While

motivation is required to establish a *prima facie* case of obviousness, a *prima facie* case of obviousness cannot be established where all the limitations of a claimed combination are not taught or suggested by the prior art. Simply citing a desire to combine or modify a reference(s) without showing that all the limitations are taught or suggested in the prior art is not sufficient to establish a *prima facie* case of obviousness.

For example, while the action asserts that the scope of the invention stated in Acres is to change any game machine aspects/behaviors with respect to time (see action, pages 3 and 7), expressions of intent or hypothetical scope of applicability without any accompanying specific disclosure is insufficient to disclose or suggest each and every element of a claim. This is especially true when Acres teaches changing gaming machine aspects/features that do not include a minimum bet or denomination. In fact, the portion of Acres relied upon by the action states only that “it would be desirable to change the sound effects and appearance of the machine in response to time,” (see Acres, column 3, lines 17-20), and does not refer to just any gaming parameter contrary to the assertion of the action. Accordingly, despite the assertions of the action, it remains that Acres does not teach or suggest changing a minimum bet or denomination in response to a time signal.

Further, the action asserts that Acres states a desire for the casino to set the cost to the player at a higher level during high demand periods to increase revenue and at a lower level at low demands periods to attract players (see action, pages 4 and 7). Again, this is only a stated desire to adjust the cost to a player, and not an actual disclosure or suggestion of changing a minimum bet or a denomination in response to a time signal. Although the action attempts to interpret cost as the minimum wager or coin-in amount (see action, page 4), the action contradicts itself by stating that Acres lacks disclosure of a controller that changes a minimum bet in response to the time signal. Still further, the disclosure of Acres contradicts the assertion of the action. The portion of Acres cited in the action states only that “during evenings and into the early morning hours on weekends—and especially on certain holidays—there are greater numbers of players placing wagers than, e.g., on a Tuesday morning between 7:00 am and noon. It would therefore be desirable for the casino to set the cost to the player at a higher level during the high demand periods and at a lower level, to attract players, during low demand periods.” The cited portion does not define “cost” as a minimum wager or coin-in amount, but merely states that it is desirable to set the cost to the

player during different demand periods. However, as stated above, the cited portion must be read in the context of the entire reference and not in a vacuum. See MPEP 2141.02(VI). When reviewing the reference as a whole, Acres clearly teaches that cost to the player refers to the net cost to the player per unit time for playing casino games. (See, column 6, lines 13-62; column 9, lines 4-7). This disclosure cannot be ignored. Acres specifically discloses a definition of cost different from the assertion of the action. Accordingly, not only does Acres not specifically disclose changing a minimum bet or denomination in response to a time signal as admitted in the action, but Acres also does not suggest changing a minimum bet or denomination in response to a time signal.

Likewise, the action only cites a desire of Burns et al. to eliminate the necessity of having slot machines dedicated to a particular amount of wager and to change the wager limits (see action, pages 4 and 7), but not an actual disclosure or suggestion of changing a minimum bet or a denomination in response to a time signal. As established above, when reviewing the reference as a whole, Burns et al. discloses offering the player the opportunity to select the minimum wager. Burns et al. does not disclose changing a minimum bet or a denomination in response to a time signal. In fact, as acknowledged in the action, Burns et al. discloses that it is difficult to change the wager limits (see action, page 7), thereby demonstrating a long felt need to change wager limits. This is objective evidence of nonobviousness. See MPEP 2141(III). While Burns et al. addresses this need by offering the player the opportunity to select a minimum wager, Burns et al does not change a minimum bet or a denomination in response to a time signal, as recited by claims 91-113.

While the action asserts that it is well known in the art for casinos to change or alter the coin-in or minimum wager amount at their discretion for purposes of increasing revenue during high demand period and attracting players during low demand periods, the assertion does not demonstrate actual disclosure or suggestion in the prior art of changing a minimum bet or denomination in response to a time signal. Instead, the action merely asserts that casinos have changed the minimum bet or coin-in amount in response to demand, and not that a minimum bet or a denomination was changed in response to a time signal.

As a result, the action has been unable to cite to any prior art, including Acres and Burns et al., that discloses or suggests changing a minimum bet or denomination in response to a time signal. Indeed, the crux of the action's obviousness rejection is that it would be


obvious to change a minimum wager or denomination in response to a time signal without actually citing any prior art that discloses changing a minimum wager or denomination in response to a time signal. Even if one of ordinary skill in the art were motivated to combine the teachings of Acres and Burns et al. based upon a desire to change the cost of a gaming machine during certain time periods to increase revenue and attract more players, it remains that neither Acres nor Burns et al. actually teaches or suggests changing a minimum bet or denomination in response to a time signal. As such, the combination of Acres and Burns et al. would not provide the gaming machine of claims 91-113. It is clear that a *prima facie* case of obviousness cannot be established where all the limitations of a claimed combination are not taught or suggested by the prior art. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See also MPEP 2143.03.

Accordingly, the applicant respectfully submits that amended independent claims 91 and 103 are in allowable form. Further dependent claims 92-102 and 104-113 which are dependent on the aforementioned independent claims are also submitted to be in allowable form. In light of the foregoing, the prompt issuance of a notice of allowance is respectfully solicited. Should the Examiner have any questions, the Examiner is respectfully invited to telephone the undersigned.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive
6300 Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300

By:



Aaron M. Peters
Registration No.: 48,801
Attorney for Applicant

January 2, 2007